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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/537,176	03/29/2000	Marco Caeran	P18888	6098

7055 7590 07/22/2003

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EXAMINER

MOHANDESI, JILA M

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 07/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/537,176

Applicant(s)

CAERAN, MARCO

Examiner

Jila M Mohandesi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-13, 15, 17-20, 24-27, 29, 30 and 33-35 is/are pending in the application.
- 4a) Of the above claim(s) 19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-13, 15, 17, 18, 24-27, 29, 30 and 33-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Request for Continued Examination

1. The request filed on 06 May 2003 for a Request for Continued Examination (RCE) under 37 CFR 1.53(d) based on parent Application No. 09/537,176 is acceptable and a RCE has been established. An action on the RCE follows.

Election/Restrictions

2. Claims 19-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 5. Under MPEP 809 and 809.02 (a) there is no requirement to prove whether there is a serious burden on the examiner to examine the species. If applicant's traverse is based upon an admission that the species identified are not patentable distinct, applicant should admit on the record that this is the case.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2-13, 15, 17-18, 24-27, 29, 30 and 33-35 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 24, the phrase "at least said lateral portion of said flexible frame being spaced above said external sole, said lateral portion of said flexible frame being connected to said external sole" is vague, inaccurate and indefinite. It is not clear how

the lateral portion is **spaced above** said external sole while being **connected** to the external sole.

Claim 24 recites the limitation "said external sole" in line 8. There is insufficient antecedent basis for this limitation in the claim. It appears that applicant is using "external sole" and "outer sole" to refer to the same structural element, if that is the case "external sole" should be amended to uniformly recite "outer sole" to more closely mirror the language used when the element is first introduced.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. The claimed invention is directed to non-statutory subject matter. Because claim 24 positively recites a part of a human body, it is directed to nonstatutory subject matter. In claim 24, lines 9 and 10, and claim 4, lines 2 and 3, alternative language such as "adapted to be attached" can be used to overcome this rejection.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2-12, 15, 17-18, 24-27, 29, 30 and 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoshizaki et al. (5,498,033). Hoshizaki '033

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discloses all the limitations of the claims such as a sports boot that permits a certain amount of dorsal and plantar flexion, comprising an outer sole and an external upper overlying the outer sole and covering a user's foot and lower leg. Inasmuch as applicant has defined its upper to be flexible, Hoshizaki '033 also discloses an upper including a flexible (capable of bending during use) plastic (which is substantially non-stretchable, since it improves the overall strength and rigidity of the skate boot) frame 1 having several cut-out areas which allow for a certain amount of flexion, the flexible frame comprising a dorsal portion comprising at least one lateral arm (7) laterally connecting an upper end of the dorsal portion and connected to said outer sole, said flexible frame not extending through a lower surface of said outer sole. See column 2, lines 11-13 and Figures 1 and 4 embodiments.

With regard to the location of where the lateral arm is fixed to the outer sole, this will depend on the size and shape of the foot of the user. The location of the metatarsophalangeal joint will depend on the size and the shape of each individual user and will vary from one user to another. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to rearrange the location of where the lateral arm is fixed to the outsole, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

With regard to claim 15, note the lateral arms (7), which are in the form of flat bands.

With regard to claim 17, note recess 5 and 15 and notch 8 in Figure 4 embodiment.

With regard to claims 25, 26, 29 and 30 which further limit the material of the flexible frame; it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

With respect to claims 34 and 35, it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

9. Claims 13 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoshizaki '033 in view of Bourdeau (5,887,886). Hoshizaki '033 as described above discloses all the limitations of the claims except the dorsal portion extending from the outer sole substantially up to a top end of the external upper at about mid-height of a tibia area of the boot and for the flexible frame to at least include a space between said dorsal portion and said other sole. Bourdeau '886 discloses a frame where the dorsal portion extends from the outer sole substantially up to a top end of the external upper at about mid-height of a tibia area of the boot and bearing a wide scallop **44** at the level of the heel which provides a space between the dorsal portion and the outer sole so as to allow the positioning of shock absorbing means at this level, and to allow tactile sensations of the heel (see Figure 2 embodiment). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the dorsal portion of Hoshizaki '033 extend from the outer sole substantially up to a top end of the external upper at about mid-height of a tibia area of the boot and bearing a wide scallop at the level of the heel of the flexible frame as taught by Bourdeau '886 so

as to allow the positioning of shock absorbing means at this level, and to allow tactile sensations of the heel.

Response to Arguments

10. Applicant's arguments filed October 07, 2002 have been fully considered but they are not persuasive.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

11. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the above mentioned references are both directed to a sports boot and it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the sports

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boot of Hoshizaki '033, via the teachings of Bourdeau '886, so as to allow the positioning of shock absorbing means at this level, and to allow tactile sensations of the heel.

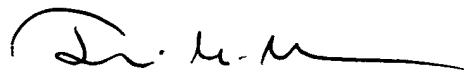
Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M Mohandesi whose telephone number is (703) 305-7015. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (703) 308-2672. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

J. MOHANDESI
PATENT EXAMINER


Jila M Mohandesi
Examiner
Art Unit 3728

JMM
July 21, 2003